



Serial No.: 10/813,314
Confirmation No.: 3626
Applicant: KIPPIE, David P.
Atty. Ref.: PA-00404US

REMARKS:

REMARKS REGARDING CLAIMS AMENDMENTS:

Claims 1, 4-6, 11, and 14-17 have been amended to further clarify that the wellbore fluid.

Claims 7 and 8 were previously canceled.

Claim 19 is new.



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IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. § 112(1):

Claims 1-6, 9, and 10 have been rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement. Examiner contends that the claims content subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art. Specifically, Examiner contends that there is no written description to support that the monovalent cation containing well fluid comprises a single brine system. Applicant has amended Claims 1-6, 9, and 10, rendering this rejection moot.

Applicant submits that the above amendment overcomes the rejection of the claims under 35 U.S.C. § 112, first paragraph, and thus ask that the Examiner reconsider and withdraw the rejection of the claims and indicate allowance in the next paper from the Office.

Examiner has also rejected Claims 11, 15, and 17 as failing to comply with the written description requirement. Specifically, Examiner contends that there is no written description to support the limitation of the aqueous monovalent brine system comprising at least 90% of the well fluid. Applicant traverses this rejection. Applicant respectfully directs Examiner's attention to paragraph's [0031]-[0042], and specifically to paragraphs [0031] and [0040], which outline formulations. The brine present in the formulations is at least 90% by weight of the formulation.

In view of the above, Applicant requests the reconsideration and withdrawal of the rejection of claims 11, 15, and 17 under 35 U.S.C. § 112, and ask that the Examiner indicate the allowance of the claims in the next paper from the Office.

REJECTION UNDER 35 U.S.C. § 112(2):

Examiner rejected Claims 11, 15, and 17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Examiner contends that the claims are indefinite because "the phrase 'the aqueous monovalent brine system comprises at least 90% of the well fluid' is indefinite because it is unclear as to whether the recited range is by total well fluid weight, volume, or other measurement."

Applicant has amended Claims 11, 15, and 17, rendering this rejection moot. Applicant submits that the above amendment overcomes the rejection of the claims under 35 U.S.C. § 112,



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second paragraph, and thus ask that the Examiner reconsider and withdraw the rejection of the claims and indicate allowance in the next paper from the Office.

Examiner also rejected Claims 1-6 and 9-18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Specifically, Examiner contends that the claims are indefinite because the claims recite a "monovalent cation containing a well fluid comprising an aqueous monovalent brine system and...a starch derivative...wherein the aqueous monovalent brine system consists essentially of at least 0.6 equivalents per liter of a water soluble monovalent cation salt..." Examiner contends that the "comprising of" and "consisting essentially of" language renders the claims unclear as to whether the well fluid can further comprise a second aqueous solution system that is not a monovalent brine system, or, alternatively, if the well fluid recited in the claim is intended to be limited to "comprising" only one monovalent brine solution.

Applicant has amended Claims 1-6 and 9-18, rendering this rejection moot. Applicant submits that the above amendment overcomes the rejection of the claims under 35 U.S.C. § 112, second paragraph, and thus ask that the Examiner reconsider and withdraw the rejection of the claims and indicate allowance in the next paper from the Office.

Examiner further rejected Claims 1, 4, 6, 11, 15, and 17 as being indefinite, contending that the phrase "wherein the monovalent cation salt is substantially free of divalent cations" is vague and confusing. Examiner further contends that it is unclear how a monovalent cation salt compound can contain a divalent cation in the first place. Applicant traverses this rejection. During examination, the USPTO must give claims their broadest reasonable meaning in light of the specification. This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989). Applicant respectfully directs Examiner to numbered paragraph [0015], wherein Applicant specifically defines this phrase to include the divalent cations which are unavoidably and unintentionally entrained and dissolved in the recited well fluid. This term is both defined in the specification and well understood by one of ordinary skill in the art. Accordingly, recitation of this phrase does not render the claims vague and confusing.



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In view of the above, Applicant requests the reconsideration and withdrawal of the rejection of claims 1, 4, 6, 11, 15, and 17 under 35 U.S.C. § 112, and ask that the Examiner indicate the allowance of the claims in the next paper from the Office.

REJECTION UNDER 35 U.S.C. § 102:

Claims 1-6 and 9-18 have been rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,804,535 to Dobson et al. (Dobson.) Applicant requests that the Examiner reconsider and withdraw the rejection in view of the following.

For there to be anticipation under 35 U.S.C. § 102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Dobson does not teach each and every element found in the claims. Dobson is generally directed to a well drilling and servicing fluid comprising a biopolymer viscosifier, a modified starch fluid loss control additive, and an aqueous brine having dissolved therein a formate salt selected from the group consisting of potassium formate, cesium formate, and mixtures thereof. Dobson also discloses that the well drilling and servicing fluid that may also contain a biopolymer viscosifier such as xanthan gum, as well as bridging agents, weight materials,...and the like. (Dobson, Col. 3, Lns. 64-65; Col. 6, Lns. 28-35).

Dobson fails to teach or suggest a well fluid substantially free of xanthan gum. Rather, Dobson teaches just the opposite, in that xanthan gum is the preferable biopolymer viscosifier. (Dobson, Col. 3, Lns. 64-67; Col. 4, Lns. 1-18; Col 8, Lns. 33-67. Col. 9, Lns. 1-45; Col. 11, Lns. 16-67). As Dobson completely fails to teach or suggest a monovalent cation containing well fluid substantially free of xanthan gum, Dobson does not teach each and every element of the claims in as complete detail as found in the claims.

Dobson also fails to disclose or suggest a brine system comprising a *water soluble* monovalent cation salt, wherein the anion of the monovalent cation salt is a *halide*. Instead, Dobson teaches that the salt of the brine system is a formate salt selected from the group consisting of potassium formate, cesium formate, and mixtures thereof. (Dobson, Col. 6, Lns. 13-15). Presumably, Examiner may consider that the potassium chloride bridging agent of Dobson would be considered suitable for the water soluble monovalent cation salt of the claimed invention. However, Dobson discloses that the bridging agent of the well drilling and servicing fluid is suspended in the well drilling and servicing fluid, and that the potassium chloride bridging agent *must not be appreciably soluble* in the liquid used to prepare the fluid. (Dobson, Col. 6, Lns. 43-45). This is because Dobson does not wish the bridging agent to dissociate and interfere with the formate ions of the brine system, which would result in precipitate formation. Dobson clearly outlines that this is an undesirable effect. (Dobson, Col. 6, Lns. 21-27). Thus, the anion of the *water soluble* salt of Dobson can only be formate, which is not a halide. Therefore, Dobson does not disclose or suggest an anion of a monovalent cation salt being a halide.

Dobson also does not disclose or suggest the high shear rate viscosity found in the claims. Examiner admits as much in the First Office Action, dated May 4, 2006. In that Office Action, Examiner indicated that Dobson would inherently have the same rheological and physical properties because the Dobson well drilling fluid allegedly has the same composition as the well drilling fluid of the present invention. (First Office Action, Item 4, Page 4). Applicant respectfully disagrees with Examiner's conclusion. As discussed above, Dobson and the present invention have completely different brine systems, thereby resulting in completely different compositions. Therefore, there is zero support that Dobson would inherently have the same



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rheological and physical properties as the drilling fluid of the present invention. Consequently, Dobson does not teach each and every element found in the claims.

In view of the above, Applicant requests the reconsideration and withdrawal of the rejection of claims 1-6 under 35 U.S.C. §102 and ask that the Examiner indicate the allowance of the claims in the next paper from the Office.

REJECTION UNDER 35 U.S.C. § 103:

Claims 9 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Dobson. Applicant requests that the Examiner reconsider and withdraw the above rejection of the claims in view of the following.

A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966), see also *Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 U.S.P.Q. 2d 1948, 1953 (Fed. Cir. 1999).

Claims 9, 10, 13, and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dobson. As discussed above, Dobson fails to disclose or suggest all the limitations recited by Applicant. As such, Dobson cannot reasonably be found to obviate Applicant's presently claimed invention.

Given the above, Applicant requests that the rejection of claims 9, 10, 13, and 17 under 35 U.S.C. §103(a) be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 13-3082, Order No. PA-00404US.



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In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Sara K. M. Hinkley".

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